

REMARKS

Claims 1-47 have been examined and are rejected. Specifically, claims 1-15 and 18-47 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over a newly applied publication corresponding to the *PrimaSoft Dialer* version 1.4 software, copyright 1995, 96 by PrimaSoft PC, Inc. (hereinafter “Dialer”); and claims 11 and 16-17 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over a newly applied publication corresponding to the *Contact Book* version 4.4 software, copyright 1994, 97 by PrimaSoft PC, Inc. (hereinafter “Contact Book”).

As an initial matter, claims 1, 5, 10, 22 and 23 are amended to further clarify the features recited therein. Furthermore, the features of claims 24-26, 29-31, 38-40 and 43-45 are incorporated into claims 1, 5, 10 and 23, respectively. Consequently, claims 24-26, 29-31, 38-40 and 43-45 are canceled to avoid redundancy. Additionally, claims 11, 13, 15-21 and 41-42 are canceled without prejudice or disclaimer. Accordingly, claims 1-10, 12, 14, 22-23, 27-28, 32-37 and 46-47 are pending in the application.

As noted above, claims 1-10, 12, 14, 22-23, 27-28, 32-37 and 46-47 stand rejected under § 103(a) as allegedly being unpatentable over Dialer.

Claim 1 recites, *inter alia*, “performing a first operation to: select a string of character information in a window displayed by the operating system, and store the selected string of character information.” Claim 1 also recites “performing a second operation to: extract a telephone number from the stored string of character information; and automatically dial a call to a line based upon the extracted telephone number.” In claim 1, the first operation “is a

designation of a region of the displayed window containing the character information” and the second operation is “one of pressing at least one button of a pointing device and pressing at least one key of a keyboard.”

Thus, claim 1 requires, for example, that a second operation, which is either pressing one or more buttons of a pointing device or pressing one or more keys of a keyboard, results in a telephone number being extracted from a selected string of character information and then the a call being automatically dialed based on the extracted number. It is respectfully submitted that Dialer fails to disclose or suggest these features of claim 1.

The Examiner alleges that Dialer allows a user to enter a telephone string into a text box of a call-dialing program and then actuate a dial button to dial the telephone string (Office Action: page 2). Dialer, however, fails to disclose or suggest a second operation that results in a telephone number being extracted from the telephone string and then automatically dialing a call based on the extracted number, wherein the second operation is “one of pressing at least one button of a pointing device and pressing at least one key of a keyboard.”

Instead, in Dialer, once a telephone string is selected (*e.g.*, from the Windows Notepad application), a user must shift focus to a call-dialing window (*e.g.*, the PrimaSoft Dialer window), the user must activate the cursor in the “Number To Dial” text box, the user must paste the telephone string into the text box, and then the user must actuate a separate dial button in the call-dialing window. This is hardly the same as automatically dialing a call to a line based upon an extracted telephone number in response to a single (*i.e.*, the second) operation, let alone that

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Application No. 09/238,502
Attorney Docket No. Q52863

this second operation is one of pressing one or more buttons of a pointing device or pressing one or more keys of a keyboard. Additionally, Dialer fails to disclose or suggest any extracting of a telephone number from a stored string of character information in response to a second operation, let alone the automatic call dialing based on the same second operation.

For at least these exemplary reasons, claim 1 is not rendered obvious by Dialer. Claims 5, 10, 22 and 23 recite features similar to those found in claim 1. Therefore, claims 5, 10, 22 and 23 are patentable over Dialer based on a rationale analogous to that set forth above for claim 1. Consequently, claims 2-4, 6-9, 12, 14, 27-28, 32-37 and 46-47 are patentable over Dialer, at least by virtue of their dependency.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Application No. 09/238,502
Attorney Docket No. Q52863

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER


Howard L. Bernstein
Registration No. 25,665

Date: August 31, 2005